



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 17

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Carteret, NJ 07008

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SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

ON PETITION

In re Application of
Richard J. Petrocy
Application No. 08/807,567
Filed: February 28, 1997
For: SELF ADDRESSING CONTROL UNITS
AND MODULAR SIGN INCLUDING
PLURALITY OF SELF-ADDRESSING
CONTROL UNITS

This is a decision on the petition under 37 C.F.R. § 1.137(a), filed January 21, 1999, to revive the above-identified application. The petition under 37 CFR 1.48(b) requesting correction of inventorship which will be treated as a petition under 37 CFR 1.48(a) based upon the statements made by the petitioner that the inventor sought to be deleted should not have been included as a joint inventor for the above-identified application, will be held in abeyance until such time as the application is revived pursuant to a grantable petition under 37 CFR 1.137.

The petition is under 37 CFR 1.137(a) is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

This application became abandoned for failure to timely and effectively reply to the Office action mailed June 17, 1998. Accordingly, this application became abandoned at midnight on September 17, 1998. A Notice of Abandonment was mailed on January 25, 1999.

Effective December 1, 1997, the provisions of 37 CFR 1.137(a) now provide that where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(a). A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy requirements (1) and (3) above.

Failure to Submit the Required Reply

Petitioner has not submitted a proper reply to the Office action mailed June 17, 1998. In the instant case the required reply can consist of an Amendment, Request for Reconsideration, or a continuing application. An Amendment or Request for Reconsideration must comply with 37 CFR 1.111 which sets forth the requirements for a reply and 37 CFR 1.121 which sets forth the manner in which any amendments are to be made. 37 CFR 1.111 states, "in order to be entitled to reconsideration or further examination, the applicant or patent owner must reply" and "the reply must:

(1) be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action;

(2) reply to every ground of rejection in the Office action;

(3) present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references;

(4) appear to be a *bona fide* attempt to advance the application to final action;

(5) in amending the claims, clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made; and

(6) show how the amendments avoid such references or objections.

Petitioner has stated that the proposed response is enclosed with the instant petition, (See #3 of Petition for Revival of Application for Patent Abandoned Unintentionally under 37 CFR 1.137(a)), however none of the documents submitted, a Petition to Correct Inventorship, and the Interview Summary and Response to Interview Request, meet the requirements set forth above. It is clear that petitioner is not familiar with the rules and procedures to be followed in effectively prosecuting a patent application and it is recommended that petitioner retain the service of a registered practitioner if further attempts to revive the above-identified application are to be made.

Failure to present an Adequate Showing of Unavoidable delay

The Commissioner may revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Heinrich, 1913 Dec. Comm'r pat. 139, 141 (Comm'r Pat. 1913). In addition, decision on revival are made on a case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977,982 (D.C. Cir. 1982). Finally, the burden of showing the cause of the delay is on the person seeking to revive the application, Smith v. Mossinghoff, Id., and a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D.Ind. 1987).

The test of unavoidable delay is the "reasonably prudent person" test set forth In re Mattullath, 38 App.D.C. 497, 514-15 (D.C. Cir. 1912): " the test of whether the delay is unavoidable is applicable to ordinary human affairs, and requires no more or greater care or diligence that is generally used and observed by prudent and careful men In relation to their most important business".

There are three periods to be considered In treating a petition to revive under 37 CFR 1.137(a): (1) the delay In reply that originally resulted In the abandonment; (2) the delay In filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and (3) the delay In filing a grantable petition pursuant to 37 CFR 1.137 to revive the application.

With respect to the first period, an application is abandoned "unavoidably" only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received In the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 14887).

The showing on the record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Petitioner asserts that his counsel withdrew from representation and did not provide a copy of the Office action mailed June 17, 1998. (See Paper No. 10, Interview Summary, October 6, 1998). However, petitioner's former counsel states in the Application to Withdraw from Attorney of Record filed September 25, 1998, that a copy was sent to the Applicant, but refers to a Restriction requirement of which there is no record in the application file. Therefore, an adequate showing of unavoidable delay should include a showing from the prior counsel as to whether or not a copy of the June 17, 1998, action was sent to petitioner, and if a copy of the action was sent to petitioner, evidence of when it was sent to petitioner and when it was received by petitioner, as well as a copy of the action sent and any other correspondence or communications sent to petitioner which may be relevant to determining what action was taken to prevent the above-identified application from becoming abandoned while in the control of the withdrawing attorney.

If revival of the above-identified application is pursued, petitioner may also wish to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application. A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). If petitioner elects to file a petition to revive an unintentionally abandoned application, a CPA request under 37 CFR 1.53(d) may be filed as the required reply with the correct inventors identified. Blank petition for revival under 37 CFR 1.137(b) and Request for CPA under 37 CFR 1.53(d) forms are provided for petitioner's convenience.

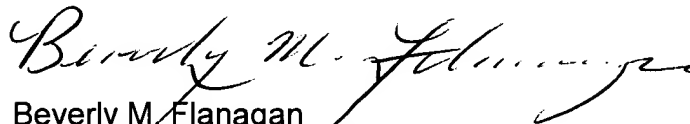
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA

Telephone inquiries should be directed to Petitions Attorney, Jennifer M. Hayes, at (703) 306-5608.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Attachment: blank form for Petition to Revive an Unintentionally Abandoned
Application under 37 CFR 1.137(b)
blank CPA request under 37 CFR 1.53(d) form

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

Docket Number (Optional)

First named inventor:

Group Art Unit:

Application Number:

Examiner:

Filed:

Title:

Attention: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703)305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to the Office action mailed on _____, which set a _____ month/day period for reply. The abandonment date of this application is _____ (i.e., the day after the expiration date of the period set for reply plus any extensions of time obtained therefor).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee – required for all utility and plant applications filed before June 8, 1995, and for all design applications; and
- (4) Adequate showing of the cause of unavoidable delay

1. Petition fee

- ☐ small entity - fee \$ _____ (37 CFR 1.17(l)).
- ☐ small entity statement enclosed herewith.
- ☐ small entity statement previously filed.
- ☐ other than small entity - fee \$ _____ (37 CFR 1.17(l)).

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in

the form of _____ (identify the type of reply):

- ☐ has been filed previously on _____.
- ☐ is enclosed herewith.

B. The issue fee of \$ _____

- ☐ has been paid previously on _____.
- ☐ is enclosed herewith.

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$_____ for a small entity or \$_____ for other than a small entity) disclaiming a period equivalent to the number of months from the date of abandonment to the filing of this petition is enclosed herewith.

4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

Date

Signature

Telephone

Number: (____) _____

Typed or printed name

Address

Enclosures: ☐ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Small Entity Status Form

☐ Additional sheets containing statements establishing unavoidable delay

☐ _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

☐ transmitted by facsimile on the date shown below to the Patent and Trademark Office at (703) 308-6916.

Date

Signature

Typed or printed name of person signing certificate

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY
UNDER 37 CFR 1.137(a)**

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants and by any other party who is presenting statements concerning the cause of delay.

Date

Signature

Typed or printed name

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply)

(Please attach additional sheets if additional space is necessary)

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)		Docket Number (Optional)
First named inventor:		
Application No.:		Group Art Unit:
Filed:		Examiner:
Title:		
Attention: Office of Petitions Assistant Commissioner for Patents Box DAC Washington, D.C. 20231		
NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703)305-9282.		
The above-identified application became abandoned for failure to file a timely and proper reply to the Office action mailed on _____, which set a _____ month/day period for reply. The abandonment date of this application is _____ (i.e., the day after the expiration date of the period set for reply plus any extensions of time obtained therefor).		
APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION		
NOTE: A grantable petition requires the following items:		
(1) Petition fee;		
(2) Reply and/or issue fee;		
(3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8, 1995, and for all design applications; and		
(4) Statement that the entire delay was unintentional.		
1. Petition fee		
<input type="checkbox"/> Small entity - fee \$_____ (37 CFR 1.17(m))		
<input type="checkbox"/> Small entity statement enclosed herewith.		
<input type="checkbox"/> Small entity statement previously filed.		
<input type="checkbox"/> Other than small entity - fee \$_____ (37 CFR 1.17(m))		
2. Reply and/or fee		
A. The reply and/or fee to the above-noted Office action in the form of _____ (identify type of reply):		
<input type="checkbox"/> has been filed previously on _____.		
<input type="checkbox"/> is enclosed herewith.		
B. The issue fee of \$ _____		
<input type="checkbox"/> has been paid previously on _____.		
<input type="checkbox"/> is enclosed herewith.		

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

- ☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$_____ for a small entity or \$_____ for other than a small entity) disclaiming a period equivalent to the number of months from the date of abandonment to the filing of this petition is enclosed herewith.

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. Check box A, or check box B and/or C as applicable and include an explanation of the delay on a separate sheet or on supplemental sheet PTO/SB/64A.

- ☐ A This petition is filed within three months of the date the applicant was first notified, or otherwise became aware, that the application was abandoned and within one year of the date of abandonment of the application.
- ☐ B This petition is **not** filed within three months of the date the applicant was first notified, or otherwise became aware, that the application was abandoned. A detailed explanation of the cause of the delay in filing the petition is attached on a separate sheet or on supplemental sheet PTO/SB/64A.
- ☐ C This petition is **not** filed within one year of the date of abandonment of the application. The applicant first became aware of the abandonment on _____. A detailed explanation of the delay in discovering the abandoned status of the application is attached on a separate sheet or on supplemental sheet PTO/SB/64A.

Date

Telephone
Number: (____) _____

Signature

Typed or printed name

Address

- Enclosures: ☐ Fee Payment
- ☐ Reply
- ☐ Terminal Disclaimer Form
- ☐ Small Entity Status Form
- ☐ Additional sheets containing statements establishing unintentional delay
- ☐ _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- ☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.
- ☐ transmitted by facsimile on the date shown below to the Patent and Trademark Office at (703) 308-6916.

Date

Signature

Typed or printed name of person signing certificate